



ITW

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application Number	10/691,755
		Filing Date	October 22, 2003
		First Named Inventor	CHISHTI, MUHAMMAD
		Art Unit	3732
		Examiner Name	JOHN J. WILSON
Total Number of Pages in This Submission	6	Attorney Docket Number	018563-005020US / AT-00107.2

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input checked="" type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Postcard
Remarks		The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Townsend and Townsend and Crew LLP James M. Heslin	Reg. No. 29,541
Signature		
Date	May 4, 2004	

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	JoAnn Evangelista		
Signature		Date	May 4, 2004

FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 130

Complete if Known

Application Number	10/691,755
Filing Date	October 22, 2003
First Named Inventor	CHISHTI, MUHAMMAD
Examiner Name	JOHN J. WILSON
Art Unit	3732
Attorney Docket No.	018563-005020US / AT-00107.2

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:
Deposit
Account
Number

20-1430

Deposit
Account
Name

Townsend and Townsend and Crew LLP

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
		1001	770	2001 385 Utility filing fee	
		1002	340	2002 170 Design filing fee	
		1003	530	2003 265 Plant filing fee	
		1004	770	2004 385 Reissue filing fee	
		1005	160	2005 80 Provisional filing fee	

SUBTOTAL (1)

(\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Independent Claims	Multiple Dependent	Extra Claims	Fee from below	Fee Paid
			** =	X	
			** =	X	
			X		

Large Entity	Small Entity	Fee Code	Fee (\$)	Fee Description
		1202	18	2202 9 Claims in excess of 20
		1201	86	2201 43 Independent claims in excess of 3
		1203	290	2203 145 Multiple dependent claim, if not paid
		1204	86	2204 43 ** Reissue independent claims over original patent
		1205	18	2205 9 ** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large	Entity	Small	Entity	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65			Surcharge - late filing fee or oath	
1052	50	2052	25			Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130			Non-English specification	
1812	2,520	1812	2,520			For filing a request for reexamination	
1804	920*	1804	920*			Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*			Requesting publication of SIR after Examiner action	
1251	110	2251	55			Extension for reply within first month	
1252	420	2252	210			Extension for reply within second month	
1253	950	2253	475			Extension for reply within third month	
1254	1,480	2254	740			Extension for reply within fourth month	
1255	2,010	2255	1,005			Extension for reply within fifth month	
1401	330	2401	165			Notice of Appeal	
1402	330	2402	165			Filing a brief in support of an appeal	
1403	290	2403	145			Request for oral hearing	
1451	1,510	1451	1,510			Petition to institute a public use proceeding	
1452	110	2452	55			Petition to revive - unavoidable	
1453	1,330	2453	665			Petition to revive - unintentional	
1501	1,330	2501	665			Utility issue fee (or reissue)	
1502	480	2502	240			Design issue fee	
1503	640	2503	320			Plant issue fee	
1460	130	1460	130			Petitions to the Commissioner	
1807	50	1807	50			Petitions related to provisional applications	
1806	180	1806	180			Submission of Information Disclosure Stmt	
8021	40	8021	40			Recording each patent assignment per property (times number of properties)	
1809	770	2809	385			Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385			For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385			Request for Continued Examination (RCE)	
1802	900	1802	900			Request for expedited examination of a design application	

Other fee (specify) _____ TERMINAL DISCLAIMER _____

130

*Reduced by Basic Filing Fee Paid SUBTOTAL (3)

(\$130

SUBMITTED BY

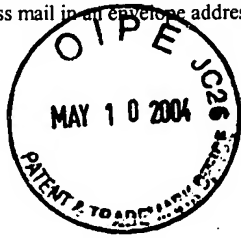
Complete (if applicable)

Name (Print/Type)	James M. Heslin	Registration No. (Attorney/Agent)	29,541	Telephone	650-326-2400
Signature				Date	05/04/04

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

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On May 4, 2004



PATENT
Attorney Docket No.: 018563-005020US
Client Ref. No.: AT-00107.2

TOWNSEND and TOWNSEND and CREW LLP

By: JoAnn Evangelista
JoAnn Evangelista

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MUHAMMAD CHISHTI, et al.

Application No.: 10/691,755

Filed: October 22, 2003

For: DEFINING TOOTH-MOVING
APPLIANCES COMPUTATIONALLY

Customer No.: 20350

Confirmation No. 6709

Examiner: JOHN J. WILSON

Technology Center/Art Unit: 3732

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed April 9, 2004, Applicants submit a Terminal Disclaimer over commonly owned U.S. Patent No. 6,471,511. As all pending claims were rejected solely for double-patenting over the '511 patent, it is believed that all pending claims are now in condition for allowance and request that the application be passed to issue at an early date.

Respectfully submitted,

James M. Heslin
Reg. No. 29,541

TOWNSEND and TOWNSEND and CREW LLP
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Attachments / JMH:jke / 60207537 v1



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER A PRIOR PATENT**

Docket Number (Optional)
018563-005020
AT-00107.2

In re Application of: MUHAMMAD CHISHTI et al.
Application No. 10/691,755
Filed: October 22, 2003
For: DEFINING TOOTH-MOVING APPLIANCES COMPUTATIONALLY

The owner*, ALIGN TECHNOLOGY, INC., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior U.S. Patent No. 6,471,511. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.



Signature

05/04/04

Date

James M. Heslin

Reg. No. 29,541

Typed or printed name

- ☐ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Certification under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

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